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EXAMINER
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ULYSSE, JAE L M

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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*Ex parte* JEAN-PIERRE RUSTER and CHANDRA SHAKER  
BUDDHAVARAM

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Appeal 2015-002611  
Application 13/191,719  
Technology Center 2400

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Before ELENi MANTIS MERCADER, ERIC S. FRAHM, and SCOTT B.  
HOWARD, *Administrative Patent Judges*.

FRAHM, *Administrative Patent Judge*.

DECISION ON APPEAL

## STATEMENT OF THE CASE

This is a decision on appeal under 35 U.S.C. § 134(a) of the final rejection of claims 1–20. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

The Examiner (i) rejected claims 1, 15, and 17 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement (Final Act. 2; Ans. 3–5); (ii) claims 1–6, 8–13, and 15–20 under 35 U.S.C. § 103(a) as being unpatentable over Aragon (US 2010/0172276 A1; published July 8, 2010) and Laroia (US 2007/0066329 A1; published Mar. 22, 2007) (Final Act. 4–29; Ans. 5–14); and (iii) claims 7 and 14 under 35 U.S.C. § 103(a) as being unpatentable over Aragon, Laroia, and Merrill (US 2012/0270497 A1; published Oct. 25, 2012) (Final Act. 29–32; Ans. 14–15).

We have reviewed Appellants’ arguments in the Briefs (App. Br. 7–25 and Reply Br. 1–7), the Examiner’s rejections (Final Rej. 2–32), the Examiner’s Advisory Action mailed May 6, 2014 (p. 2), and the Examiner’s response (Ans. 3–15) to Appellants’ arguments.

### *Written Description Rejection of Claims 1, 15, and 17*

With regard to the written description rejection, we agree with Appellants’ arguments (App. Br. 7–10; Reply Br. 1–3) that the timing features recited in claims 1, 15, and 17 are properly supported in the Specification (*see e.g.*, Figs. 4, 6, and 7; Spec. pp. 8–10 and 12) so as to convey to a person of ordinary skill in the art that Appellants had possession of the claimed subject matter at the time of filing.

*Obviousness Rejection of Claims 1–6, 8–13, and 15–20 (Aragon and Laroia)*

With regard to the obviousness rejection of independent claims 1, 11, and 17, as well as claims 2–6, 8–10, 12, 13, 15, 16, and 18–20 depending respectively therefrom, the Examiner (*see e.g.*, Ans. 6–9) relies upon Aragon (*see ¶¶ 5, 20, 21, 23, 24, 31–33, 35, and 42*) as teaching or suggesting modifying transmission power for a pilot signal based on the *frequency* of a mobility-related procedure (Final Act. 5). Although Aragon clearly discloses power saving modes for a wireless communication device (e.g., a cellular telephone), Aragon (whether taken singly or in combination with Laroia) fails to disclose, teach, or suggest *maintaining* an established and active wireless connection, transitioning from an operational mode to a low power standby mode *while maintaining* the active wireless connection, and then returning to operational mode in response to a wireless communication signal *during* the active wireless connection as claimed. As a result, we are persuaded by Appellants’ arguments (App. Br. 10–15; Reply Br. 3–7) that there is no teaching, suggestion, or disclosure in Aragon (including in any of the portions of Aragon cited by the Examiner) of “transition[ing] from an operational mode to a low power standby mode *while maintaining the active wireless connection* with the client device,” and subsequently transitioning modes in response to a wireless communication signal “*during the active wireless connection*,” as recited in independent claim 1, and as similarly recited in remaining claims 2–6, 8–13, and 15–20. In view of the foregoing, we do not sustain the Examiner’s obviousness rejection of claims 1–6, 8–13, and 15–20 over Aragon and Laroia.

*Obviousness Rejection of Claims 7 and 14 (Aragon, Laroia, Merrill)*

We also do not sustain the Examiner's obviousness rejection of claims 7 and 14 over the combination of Aragon, Laroia, and Merrill for the same reasons as provided *supra*, with respect to claims 1 and 11 from which claims 7 and 14 respectively depend, as well as two additional reasons that follow.

First, we agree with Appellants' argument (App. Br. 24) that Merrill teaches downloading an application to a local device from a network, but is silent as to doing so in order to cause generating a wireless signal. Thus, we agree with Appellants that Merrill fails to teach or suggest, whether alone or in combination with Aragon and Laroia, generating the wireless communication signal in response to a previously downloaded application as recited in claims 7 and 14.

Second, and most notably, Merrill is not evidence and does not serve to establish a prima facie case, as Merrill is not prior art to Appellants' invention. Specifically, Appellants' filing date of July 27, 2011 predates both Merrill's publication date of October 25, 2012, and filing date of April 18, 2012. In order to qualify as prior art to Appellants' claims on appeal, Merrill must rely on priority to U.S. Provisional Application No. 61/477,542 filed April 20, 2011.

In order for Merrill to qualify for the benefit of the priority filing date of its provisional application (U.S. Provisional Application No. 61/477,542) filed on April 20, 2011, the criteria of 35 U.S.C. § 119(e) and 37 C.F.R. 1.78(a)(4) – (a)(6) for the benefit claim of a prior provisional application must be met. MPEP § 201.11. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior

application (the parent or original non-provisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. § 112. *See Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551 (Fed. Cir. 1994). MPEP §§ 201.11(I), 201.11(I)(A). Accordingly, the disclosure of the prior-filed application must provide adequate support and enablement for the claimed subject matter of the later-filed application in compliance with the requirements of 35 U.S.C. § 112, first paragraph.<sup>1</sup>

Merrill's provisional application number 61/477,542 filed April 20, 2011 (*see* pp. 1–29; Figs. 1–14; Appendix A.1–A.4.5) does not provide written description support for the feature recited in claims 7 and 14 of

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<sup>1</sup> As stated in MPEP § 201.11(I)(A):

Under 35 U.S.C. 119(e), the written description and drawing(s) (if any) of the provisional application must adequately support and enable the subject matter claimed in the nonprovisional application that claims the benefit of the provisional application. In *New Railhead Mfg., L.L.C. v. Vermeer Mfg. Co.*, 298 F.3d 1290, 1294, 63 USPQ2d 1843, 1846 (Fed. Cir. 2002), the court held that for a nonprovisional application to be afforded the priority date of the provisional application, “the specification of the provisional must ‘contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms,’ 35 U.S.C. § 112 ¶1, to enable an ordinarily skilled artisan to practice the invention claimed in the nonprovisional application.”

MPEP § 201.11(I)(A).

generating a wireless communication signal *in response to* a previously downloaded application. The Examiner does not present findings or reasoning showing that the cited portions of Merrill (Merrill ¶¶ 6, 40, and 55) are supported by the requisite written description support in U.S. Provisional Application No. 61/477,542 to support the priority filing date of April 20, 2011.

In view of the foregoing, we do not sustain the Examiner's obviousness rejection of claims 7 and 14 over Aragon, Laroia, and Merrill.

#### CONCLUSION

Appellants have persuaded us of error in the Examiner's decision to reject claims 1–20.

#### DECISION

The decision of the Examiner to reject claims 1–20 is reversed.

#### REVERSED